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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,544

01/20/2006

Pierre Sevigny

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27805

7590

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EXAMINER

WOOD, AMANDA P

ART UNIT

PAPER NUMBER

1657

MAIL DATE

DELIVERY MODE

05/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/533,544	Applicant(s) SEVIGNY ET AL.	
	Examiner AMANDA P. WOOD	Art Unit 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 1-5 in the reply filed on 28 April 2008 is acknowledged. The traversal is on the ground(s) that a search for the solvent would reveal the solvent in composition with a substrate, as in claim 6. This is not found persuasive because a search for the solvent of claims 1-5 would not necessarily reveal the particular composition of claim 6, as a solvent as claimed in claims 1-5 comprises a solubilizing agent and an essential oil, and does not claim a chromogenic substrate as part of the solvent (i.e., the chromogenic substrate limitation is provided as part of the preamble, and is provided as an intended use, e.g., "solvent for chromogenic substrate for detecting presence of lacZ gene and/or lacZ gene activity").

The requirement is still deemed proper and is therefore made FINAL.

Claims 6-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 28 April 2008.

Claims 1-5 are presented for consideration on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Klopfenstein (EP 0354027 A3), as cited in the IDS filed on May 2, 2005.

A dipolar solvent is claimed for chromogenic substrate which comprises a stabilizing amount of at least one solubilizing agent selected from the group consisting of NMP, DMPU, and PC and comprises essential oil.

Klopfenstein teaches a solvent comprising N-methylpyrrolidone and cyclic terpene (i.e., NMP and an essential oil comprising pine terpenoids), see for example, col. 10 and col. 11. Although Klopfenstein does not expressly teach a solvent wherein the chromogenic substrate is X-Gal or IPTG, the solvent taught by Klopfenstein is substantially identical to that of the claims, based upon the claimed limitations, and therefore, the properties and functions are presumed to be inherently the same as that of the claimed solvent.

Therefore, the reference is deemed to anticipate the instant claims above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klopfenstein (EP 0354027 A3), as cited in the IDS filed on May 2, 2005.

A dipolar solvent is claimed for chromogenic substrate which comprises a stabilizing amount of at least one solubilizing agent selected from the group consisting of NMP, DMPU, and PC and comprises essential oil.

Klopfenstein teaches a solvent comprising N-methylpyrrolidone and cyclic terpene (i.e., NMP and an essential oil comprising pine terpenoids), see for example, col. 10 and col. 11. Klopfenstein beneficially teaches that the above solvent has various uses, including dissolving inks in the silk screen and printing industries. Although Klopfenstein does not expressly teach a solvent wherein the chromogenic substrate is X-Gal or IPTG, the solvent taught by Klopfenstein is substantially identical to that of the claims, based upon the claimed limitations, and therefore, the properties and functions are presumed to be inherently the same as that of the claimed solvent.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to provide the solvent for a chromogenic substrate based upon the beneficial teachings provided by Klopfenstein with respect to the teaching of a solvent comprising NMP and cyclic terpene, as discussed above. The result-effective

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adjustment of particular conventional working conditions (e.g., providing the solvent in a microemulsion) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole, was *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made, as evidenced by the cited references, especially in the absence of evidence to the contrary.

Conclusion

No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMANDA P. WOOD whose telephone number is (571)272-8141. The examiner can normally be reached on M-F 8:30AM -5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

APW
Examiner
Art Unit 1657

/Christopher R. Tate/
Primary Examiner, Art Unit 1655